

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

RBW STUDIO, LLC,

CASE NO. 2:24-cv-00763-JHC

Plaintiff,

ORDER GRANTING THE RUSHING
COMPANY, LLC'S MOTION FOR
JUDGMENT ON THE PLEADINGS

V.

THE RUSHING COMPANY, LLC, EITEL
ASSOCIATES, LLC, COLUMBIA
HOSPITALITY, INC, LAKE UNION
PARTNERS SEATTLE, LLC,

Defendants.

I **INTRODUCTION**

This matter comes before the Court on The Rushing Company, LLC's Rule 12(c) Motion for Judgment on the Pleadings. Dkt. # 39. RBW Studio, LLC¹ is a designer and manufacturer of unique light fixtures that owns patents for the Cinema chandelier. Dkt. # 1 at 2, 5–6, ¶¶ 5, 23, 28–29. RBW claims that Defendants violated federal and state laws by installing a similar chandelier in the State Hotel. Rushing seeks dismissal under Federal Rule of Civil Procedure

¹ During the events giving rise to this dispute, RBW conducted business as “Rich Brilliant Willing, LLC.” Dkt. # 1 at 6, ¶ 30.

12(c), contending that RBW fails to state a claim upon which relief can be granted. Dkt. # 39.
 2 The other Defendants, Lake Union Partners Seattle, LLC, Eitel Associates, LLC, and Columbia
 3 Hospitality, Inc., join Rushing's motion to the extent that it seeks dismissal of RBW's unfair
 4 competition claim under the Washington Consumer Protection Act (WCPA). Dkt. # 48. The
 5 Court has reviewed the materials filed in support of and in opposition to the motion, the rest of
 6 the case file, and the governing law. Being fully advised, the Court GRANTS Rushing's motion.
 7 And the Court GRANTS RBW leave to amend its complaint.

II BACKGROUND

9 Because Rushing brings its motion under Rule 12(c), the Court takes as true the facts
 10 alleged in the complaint. Dkt. # 1. On March 9, 2017, RBW applied for a design patent for the
 11 Cinema chandelier, a triple-tiered light fixture with spherical bulbs. *Id.* at 5, ¶ 23, 26. On
 12 November 9, 2017, while the patent application was pending, RBW provided a quote for the
 13 Cinema chandelier to Defendants, each of whom helped redevelop the State Hotel. *Id.* at 2–3, 6,
 14 ¶¶ 6–16, 30–31. Rather than buying the Cinema chandelier from RBW, Defendants had
 15 contractors design a cheaper replica (the Accused Light Fixture) and installed it in the State
 16 Hotel at some point before late 2022. *Id.* at 6–7, ¶¶ 32–34. Rushing is an architectural and
 17 interior design firm. *Id.* at 2, ¶ 9. To promote its work, Rushing uses photos of the State Hotel
 18 that include the Accused Light Fixture. *Id.* at 10–11, ¶¶ 45, 50.

19 On June 18, 2019, the U.S. Patent and Trademark Office issued Patent No. D851,806
 20 ('806 Patent) for the Cinema chandelier. *Id.* at 5, ¶ 28. On November 7, 2023, the U.S. Patent
 21 and Trademark Office issued Patent No. D1,004,180 ('180 Patent) for the spherical bulb of the
 22 chandelier. *Id.* at 6, ¶ 29.

1 RBW filed a complaint against Defendants,² bringing: (1) a patent infringement claim
 2 under 35 U.S.C. § 271; and (2) an unfair competition claim under the WCPA, RCW 19.86.020,
 3 *et seq.* *Id.* at 7–15. RBW seeks damages and an injunction requiring removal of the Accused
 4 Light Fixture from the State Hotel and enjoining Defendants from further infringing the '806 or
 5 '180 Patents. *Id.* at 15–16.

6 **III**
 7 **DISCUSSION**

8 The standards for deciding a Federal Rule of Civil Procedure 12(b)(6) motion and a Rule
 9 12(c) motion are “functionally identical.” *Cafasso, U.S. ex rel. v. Gen. Dynamics C4 Sys., Inc.*,
 10 637 F.3d 1047, 1054 n.4 (9th Cir. 2011) (citation omitted). In reviewing a motion to dismiss
 11 under Rule 12(c), a court takes all well-pleaded factual allegations as true and draws all
 12 reasonable inferences in favor of the non-moving party. *Hines v. Youseff*, 914 F.3d 1218, 1227
 13 (9th Cir. 2019). “Judgment on the pleadings is proper when the moving party clearly establishes
 14 on the face of the pleadings that no material issue of fact remains to be resolved and that [they
 15 are] entitled to judgment as a matter of law.” *Hal Roach Studios, Inc. v. Richard Feiner & Co., Inc.*, 896 F.2d 1542, 1550 (9th Cir. 1990).

16 A. RBW does not State a Patent Infringement Claim Against Rushing

17 Subject to exceptions, a defendant infringes a patent if the defendant “makes, uses, offers
 18 to sell, or sells any patented invention . . . during the term of the patent.” 35 U.S.C. § 271(a). A
 19 defendant can infringe a patent with a replica of a patented product. *See PUMA SE v. Brooks
 20 Sports, Inc.*, 2024 WL 2161215, at *4 & n.6 (W.D. Wash. May 14, 2024).

21 RBW does not dispute that a patent infringement claim cannot be based on actions that
 22 took place before issuance of the patent. *See* Dkt. # 52 at 9–11. Rather, RBW alleges that, after
 23

24 ² RBW voluntarily dismissed without prejudice Defendant Weinstein AU, PLLC. Dkt. # 38.
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1 issuance of the patents, Rushing promoted its work with photos of the State Hotel that included
 2 the Accused Light Fixture. Dkt. # 1 at 11, ¶ 50. For example, Rushing displays such a photo on
 3 its website. *Id.* at 10, ¶ 45. The question is whether including the Accused Light Fixture in
 4 photos used to promote architectural and interior design services constitutes infringing “use” of
 5 the Accused Light Fixture or an “offer to sell” it.

6 RBW does not adequately allege that Rushing’s inclusion of the Accused Light Fixture in
 7 photos used to promote its work constitutes infringing “use” under § 271(a). Merely displaying a
 8 product, “even in an obviously commercial atmosphere” does not constitute infringing “use.”
 9 *Med. Sols., Inc. v. C Change Surgical LLC*, 468 F. Supp. 2d 130, 134 (D.D.C. 2006), *aff’d*, 541
 10 F.3d 1136 (Fed. Cir. 2008) (quoting *Intermedics, Inc. v. Ventritex, Inc.*, 775 F. Supp. 1269, 1286
 11 (N.D. Cal. 1991)). RBW cites no contrary authority. Dkt. # 52 at 9–11.

12 Nor does RBW adequately allege that Rushing made an “offer to sell” the Accused Light
 13 Fixture. “An ‘offer for sale’ sufficient to give rise to liability for patent infringement must meet
 14 the traditional contract law definition of that term.” *Superior Indus., LLC v. Thor Glob. Enters.*
 15 *Ltd.*, 700 F.3d 1287, 1294 (Fed. Cir. 2012). A defendant must communicate a “willingness to
 16 enter into a bargain, so made as to justify another person in understanding that his assent to that
 17 bargain is invited and will conclude it.” *Id.* (quoting *MEMC Elec. Materials, Inc. v. Mitsubishi*
 18 *Materials Silicon Corp.*, 420 F.3d 1369, 1376 (Fed. Cir. 2005)).

19 Someone viewing Rushing’s promotional materials could only ask about—not accept an
 20 offer to sell—the Accused Light Fixture. RBW does not allege that Rushing sells light fixtures
 21 or that Rushing listed a price for the Accused Light Fixture. *See Buergofol GmbH v. Omega*
 22 *Liner Co., Inc.*, 2023 WL 4106673, at *3 (D.S.D. June 21, 2023) (dismissing a patent
 23 infringement claim “[b]ecause price terms are necessary for an offer for sale”). RBW cites *Milo*
 24 & *Gabby, LLC v. Amazon.com, Inc. (Milo & Gabby II)*, but there the court denied summary

1 judgment because the product was, among other things, listed on the defendant's website with a
 2 price. 2015 WL 4394673, at *14 (W.D. Wash. July 16, 2015).

3 RBW asserts that whether Rushing's use of photos including the Accused Light Fixture
 4 constitutes infringing "use" or an "offer to sell" is "a question of fact that need not be addressed
 5 for purposes of overcoming a 12(c) motion." Dkt. # 52 at 11. RBW cites *Richardson v. Stanley*
 6 *Works, Inc.*, for a general proposition that "[d]esign patent infringement is a question of fact."
 7 597 F.3d 1288, 1295 (Fed. Cir. 2010). But in *Richardson*, the Federal Circuit held that whether
 8 an accused product would deceive an "ordinary observer" into believing that it was the patented
 9 design was a question of fact. *Id.* The Federal Circuit did not hold that any design patent
 10 infringement claim necessarily overcomes a motion to dismiss. To be sure, whether the Accused
 11 Light Fixture resembles the Cinema chandelier may not be well-suited for resolution on the
 12 pleadings. But the Court need not reach this question because RBW fails to adequately allege
 13 that Rushing "used" or "offered to sell" the Accused Light Fixture under § 271(a).³

14 The Court dismisses the patent infringement claim against Rushing without prejudice and
 15 with leave to amend.

16 B. Federal Patent Law Preempts the WCPA Claim

17 Whether federal patent law preempts a state-law claim is determined under Federal
 18 Circuit law.⁴ *Amgen Inc. v. Sandoz Inc.*, 877 F.3d 1315, 1325–26 (Fed. Cir. 2017). Because

19 ³ As accessed at the time of issuing this Order, the link RBW provides in its complaint to
 20 Rushing's website does not show any photos including the Accused Light Fixture. Dkt. # 1 at 10, ¶ 45
 21 (referring to <https://rushingco.com/projects/the-state-hotel-2nd-and-pike/>). In its reply, Rushing provides
 22 one of its photos of the State Hotel including the Accused Light Fixture. Dkt. # 55 at 3. But the Court
 23 declines to consider the photo by converting Rushing's 12(c) motion into a motion for summary
 24 judgment. *Living Designs, Inc. v. E.I. Dupont de Nemours & Co.*, 431 F.3d 353, 363 n.9 (9th Cir. 2005).

⁴ Rushing cites *Milo & Gabby, LLC v. Amazon.com, Inc. (Milo & Gabby I)*, for the proposition
 that federal patent law can preempt a WCPA claim when the WCPA claim "merely restates" a federal
 patent law claim. 12 F. Supp. 3d 1341, 1347 (W.D. Wash. 2014). The Court agrees with this proposition

federal patent law does not expressly provide for preemption and Congress did not intend to exclusively occupy the field of unfair competition law, the issue is conflict preemption. *Ultra-Precision Mfg., Ltd. v. Ford Motor Co.*, 411 F.3d 1369, 1377 (Fed. Cir. 2005); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 166 (1989) (Congress has indicated that “the law of unfair competition” is “consistent with the balance struck by the patent laws.”). “Conflict preemption occurs when state law stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress.” *Ultra-Precision Mfg., Ltd.*, 411 F.3d at 1377 (quotation marks and citation omitted).

Federal patent law aims to “foster and reward invention” by “creat[ing] a limited opportunity to obtain a property right in an idea.” *Aronson v. Quick Point Pencil Co.*, 440 U.S. 257, 262 (1979); *Bonito Boats, Inc.*, 489 U.S. at 976–77. In determining what products can be patented, Congress struck a balance between maintaining “free competition in the exploitation of unpatented designs” and encouraging public disclosure of innovations by ensuring legal protections for certain inventions. *Bonito Boats, Inc.*, 489 U.S. at 977–78. “State law protection for techniques and designs whose disclosure has already been induced by market rewards may conflict with the very purpose of the patent laws by decreasing the range of ideas available as the building blocks of further innovation.” *Id.* at 978. Thus, “[f]ederal law preempts state law that offers ‘patent-like protection’ to discoveries unprotected under federal patent law.” *Ultra-Precision Mfg., Ltd.*, 411 F.3d at 1377–78 (quoting *Bonito Boats, Inc.*, 489 U.S. at 156). But the Supreme Court has reiterated that “[s]tate law is not displaced merely because the contract relates to intellectual property which may or may not be patentable; the states are free to regulate

for the reasons discussed in this Order but does not rely on the preemption analysis in *Milo & Gabby I* because it is based on Ninth Circuit law. *Id.* at 1347–48.

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1 the use of such intellectual property in any manner not inconsistent with federal law.” *Bonito*
 2 *Boats, Inc.*, 489 U.S. at 979–80 (quoting *Aronson*, 440 U.S. at 262).

3 The question whether a state unfair competition claim is preempted because the state law
 4 offers “patent-like protection” can overlap with the question whether a plaintiff has stated a state
 5 unfair competition claim at all. Federal patent law does not preempt a state-law claim if the
 6 claim: (1) requires proof of elements not required for a patent law claim; and (2) does not, as a
 7 practical matter, offer protections like those offered by federal patent law. *Rodime PLC v.*
 8 *Seagate Tech., Inc.*, 174 F.3d 1294, 1306 (Fed. Cir. 1999). Even if a state-law claim requires
 9 proof of elements beyond those required for a patent law claim, however, the claim may be
 10 preempted if the plaintiff fails to adequately allege those other elements. For example, in
 11 *Samiam Grp., LLC v. Coopersburg Assocs., Inc.*, a plaintiff bringing a patent claim also brought
 12 a Pennsylvania common law unfair competition claim, which required that the defendant
 13 engaged in “deceptive marketing.” 650 F. Supp. 3d 295, 317 (E.D. Pa. 2023). In holding that
 14 federal patent law preempted the Pennsylvania unfair competition claim, the court reasoned that
 15 because there was nothing deceptive about the defendant’s conduct, “[t]he only evidence of
 16 unfair competition that remains is [the plaintiff’s] evidence of potential patent infringement.” *Id.*
 17 at 319.

18 Federal patent law preempts RBW’s WCPA claim. Under the WCPA, a plaintiff must
 19 establish five elements: “(1) unfair or deceptive act or practice; (2) occurring in trade or
 20 commerce; (3) public interest impact; (4) injury to plaintiff in his or her business or property; (5)
 21 causation.” *Hangman Ridge Training Stables, Inc. v. Safeco Title Ins. Co.*, 719 P.2d 531, 533
 22 (Wash. 1986). The “unfair or deceptive act” element is not required to state a patent claim.
 23 *Mars Inc. v. Kabushiki-Kaisha Nippon Conlux*, 24 F.3d 1368, 1373 (Fed. Cir. 1994). But as

1 discussed below, RBW does not adequately allege this element in a manner consistent with
2 federal patent laws.

3 RBW says that it alleges an “unfair or deceptive act” in various ways. To show that its
4 WCPA claim requires proof of elements not required for a patent law claim, RBW breaks down
5 “unfair or deceptive act” into “unfair” and “deceptive.” Dkt. # 52 at 13–15. RBW further breaks
6 down “unfair” by asserting that Defendants’ practices offend public policy, are “immoral,
7 unethical, oppressive, [and] unscrupulous,” and “cause[] substantial injury to consumers.” *Id.* at
8 15–19 (quoting *Rush v. Blackburn*, 361 P.3d 217, 224–25 (Wash. Ct. App. 2015)). But all these
9 sub-elements are based on one allegation: to save money, Defendants “misappropriated the
10 information, time, skill, experience and financial resources invested by RBW in the research,
11 design and development of the Cinema™ chandeliers.” Dkt. # 1 at 13, ¶ 65. Thus, the Court
12 addresses these contentions together.

13 RBW does not adequately allege that Defendants engaged in an “unfair or deceptive act”
14 in a manner consistent with federal patent laws. RBW only makes conclusory allegations that
15 Defendants acted in “bad faith” and “misappropriated” information about the Cinema chandelier.
16 *Id.* at 13, ¶¶ 65–66; *see Flocast, LLC v. Movi Fam., LLC*, 2024 WL 3163485, at *11–12
17 (N.D.N.Y. June 25, 2024) (dismissing a New York common law unfair competition claim
18 because conclusory allegations of bad faith cannot “transform” a patent claim into an
19 independent unfair competition claim). RBW asserts that Defendants were deceptive because
20 they failed to disclose: (1) that they did not intend to buy the Cinema chandelier; and (2) that
21 they intended to copy its design. Dkt. # 52 at 14. Assuming arguendo that such conduct could
22 be construed as “unfair or deceptive”—which may be a leap—such a WCPA claim would be
23 preempted because federal patent law allows copying a product available to the public. *See*

1 *Bonito Boats, Inc.*, 489 U.S. at 160 (federal patent law preempts a state law prohibiting the
 2 “reverse engineering of a product in the public domain”).

3 RBW’s remaining contentions are unpersuasive but show that granting leave to amend its
 4 complaint would not be futile. RBW says that it obtained facts through informal discovery to
 5 support an allegation that Defendants induced RBW to provide confidential business
 6 information. Dkt. # 52 at 13–14. The Court does not consider these new facts because they fall
 7 outside the pleadings.⁵ Fed. R. Civ. P. 12(d). But the Court grants RBW leave to amend
 8 because federal patent law does not preempt a state unfair competition claim based on a
 9 defendant’s improperly acquiring confidential information about a product. *See Bytemark, Inc.*
 10 *v. Xerox Corp.*, 342 F. Supp. 3d 496, 507–08 (S.D.N.Y. 2018) (denying a motion to dismiss a
 11 New York common law unfair competition claim because the plaintiff alleged that the
 12 defendants pretended to form a partnership with the plaintiff to obtain confidential information).

13 RBW also says that Defendants’ use of the Accused Light Fixture is “unfair” because it
 14 violates the policy of the Lanham Act, 15 U.S.C. § 1125, which prohibits trademark
 15 infringement. Dkt. # 52 at 16. A finding of trademark infringement under the Lanham Act can
 16 constitute an “unfair or deceptive act.” *Amazon.com, Inc. v. Acar*, 2024 WL 4504749, at *4
 17 (W.D. Wash. Oct. 15, 2024). But RBW does not bring a Lanham Act claim. Nor does RBW
 18 provide support for its suggestion that the policy of the Lanham Act could support a WCPA
 19 claim involving a patent. As currently pleaded, the WCPA claim improperly seeks to provide
 20
 21

22 ⁵ RBW also contends that Defendants’ conduct is “unfair” under the WCPA because “Defendants
 23 copied images from RBW’s website without RBW’s authorization, consent, or knowledge, and without
 24 any remuneration to RBW.” Dkt. # 52 at 16. But RBW does not cite allegations in its complaint to
 25 support this contention. To the extent that this contention is based on facts different from those
 26 supporting a claim that Defendants induced RBW to provide confidential information, the Court rejects it
 27 for lack of specificity.

1 “patent-like protection” to the Cinema chandelier for the period between RBW’s providing
2 Defendants with a quote and acquiring its design patents.⁶

3 The Court dismisses the WCPA claim against Defendants without prejudice and with
4 leave to amend.

5 **IV**
6 **CONCLUSION**

7 For these reasons, the Court GRANTS Rushing’s motion to dismiss. The Court
8 DISMISSES both the patent infringement claim against Rushing and the WCPA claim against
9 Defendants without prejudice and with leave to amend. The Court GRANTS RBW leave until
10 January 7, 2025 to file an amended complaint; such leave is limited to the claims dismissed here.

11 Dated this 17th day of December, 2024.

12 

13 John H. Chun
14 United States District Judge

23 ⁶ Because RBW has not adequately alleged that Defendants caused “substantial injury” to RBW
24 distinct from patent infringement, the Court rejects RBW’s assertion that Defendants’ conduct is “unfair”
because it causes such injury to other consumers. Dkt. # 52 at 18–19 (quoting *Rush*, 361 P.3d at 224–25).
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